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Attorney Docket No. CLDM-006/01US 301185-2041   **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Vipul V. Prakash

Serial No.:   10/799,860

Filed: March 12, 2004

Confirmation No.:   1747

Group Art Unit: 2445

Examiner: Swearingen, Jeffrey R.

Title: Method and an Apparatus to Screen Electronic Communications

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

This communication is in response to the Final Official Action dated May 3, 2012.

Remarks begin on page 2.

The Commissioner is hereby authorized to charge any required fees and to credit any overpayments to Cooley LLP's deposit account No. 50-1283.

REMARKS

Claims 12-14 are allowed. Independent claim 1 is rejected for being obvious in view of U.S. Patent Publication 2004/0073617 (Milliken), U.S. Patent 7,711,779 (Goodman) and U.S. Patent Publication 2001/0037453 (Mitty). Reconsideration of the rejection is respectfully requested.

Independent claim 1 recites an operation of "generating one or more signatures using a length of the electronic communication and the URLs extracted." This solution resolves the problem of a spammer randomizing the contents of a message.

The Examiner acknowledges that this feature is not taught by Milliken or Goodman. However, the Examiner relies upon Mitty as teaching this feature. It is respectfully submitted that the Examiner is misinterpreting Mitty. This misinterpretation is predicated upon the use of ellipses to characterize the teachings in paragraph [0067] of Mitty. In particular, page 2, paragraph 2 of the office quotes paragraph [0067] of Mitty as follows:

> To create the (waybill) ID, a CRC value is generated of the encrypted message M3 and a digest of the encrypted message is generated... A long version of the ID is also created (which) consists of the concatenated string of the data information, the CRC, and the digest value of the encrypted message...sender may archive the ID, the digest of the message ... subject text, filenames, message length, and various information specific to the services requested.

The operative teaching is the single sentence: "The long version consists of the concatenated string of the date information, the CRC, and the digest value of the encrypted message." That is, the long version consists of three values: (1) the date information, (2) the CRC, and (3) the digest value of the encrypted message. Mitty does not teach any other form of a long version. The Examiner confuses issues by using ellipses to suggest that the long version may include other elements. The ellipses eliminate critical information. In particular, the ellipses are used to avoid the fact that Mitty moves on to a separate concept of archiving. That is, Mitty moves from a discussion of forming a long version of a concatenated string to a discussion of archiving transactions. The complete teaching of Mitty is as follows:

> The long version consists of the concatenated string of the date information, the CRC, and the digest value of the encrypted message. The long version of the ID is included in the waybill and stored locally. **Various aspects of the above transactions may be locally archived, if selected.** For example, using conventional techniques, sender 105 **may archive** the ID, the digest of the message M1 the digest algorithm identifier, e-mail addresses and certificates for the recipient(s) 120, subject text, filenames, message length, and various information specific to the services requested, e.g., insurance level, notary information, etc. (emphasis added)

The bolded language shows the conceptual transition that the Examiner eliminates through the use of ellipses. The message length is only taught in connection with the archiving of "the above transactions". Mitty only teaches the formation of a signature using (1) the date information, (2) the CRC, and (3) the digest value of the encrypted message. Mitty only teaches the use of a message length in connection with the archiving of transactions. Therefore, the rejection based upon Mitty is inappropriate.

Even if Mitty did teach the formation of a string using "the ID, the digest of the message M1 the digest algorithm identifier, e-mail addresses and certificates for the recipient(s) 120, subject text, filenames, message length, and various information specific to the services requested, e.g., insurance level, notary information, etc.", that would be an extremely different string than the claimed signature from a string comprising message length and a URL. Mitty discusses a long version of a string, which is inconsistent with the claimed short string.

The Examiner also states that "Mitty does more than archive a message length. Mitty creates a digest value (signature) of the message. The digest value includes the contents of the message, including the message length, subject text file names, etc." Paragraph [0067] of Mitty discusses archiving and string creation, but different parameters are suggested for archiving and string creation. Mitty teaches that: "The long version consists of the concatenated string of the date information, the CRC, and the digest value of the encrypted message." Mitty then teaches that archiving may use the following parameters: "the ID, the digest of the message M1 the digest algorithm identifier, e-mail addresses and certificates for the recipient(s) 120, subject text, filenames, message length, and various information specific to the services requested, e.g., insurance level, notary information, etc." The Examiner's substitution of archiving parameters for string formation parameters is inappropriate.

The Examiner's reliance upon paragraph [0104] of Mitty is also inappropriate. That paragraph discusses (1) generation of the original message and (2) information about the original message – the "waybill information. This information includes the ID, the sequence number, the relevant e-mail addresses and certificates, service-related information, such as the insurance level, the filenames of any attachments, the length of M1, and the time stamp information." Recovery of a message and listing information about the message does not show, suggest or render predictable the claimed operation of "generating one or more signatures using a length of the electronic communication and the URLs extracted."

The Examiner states: "Just as in [0067] where a waybill ID is created using a message length, in [0104] the information generated at step 430 includes the original message length of M1." Paragraph

[0067] teaches that the waybill includes the long version of the ID ("The long version of the ID is included in the waybill and stored locally.") and other parameters, such as message length. Paragraph [0104] teaches retrieval of a message and the listing of message parameters, such as message length. This message recovery operation and listing of parameters associated with a recovered message does not show, suggest or render predictable the claimed operation of "generating one or more signatures using a length of the electronic communication and the URLs extracted."

For these reasons, Mitty does not support a rejection of claim 1. Therefore, claim 1 and its dependent claims 2-9 should be in a condition for allowance.

Independent claim 15 specifies the use of a message length and extracted URLs to generate a signature. Therefore, claim 15 and its dependent claims 16-20 should also be in a condition for allowance.

In view of the foregoing, Applicant respectfully submits that no further impediments exist to the allowance of this application and, therefore, requests an indication of allowability. However, the Examiner is requested to call the undersigned if any questions or comments arise.

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